



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,744	11/28/2000	John Thaddeus Pienkos		8432

7590

04/06/2006

John T. Pienkos
5017 N. Hollywood Ave.
Whitefish Bay, WI 53217

EXAMINER

ZURITA, JAMES H

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,744

Applicant(s)

PIENKOS, JOHN THADDEUS

Examiner

James H. Zurita

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History

On 28 November 2000, applicant filed the instant application, claiming priority to provisional application 60/190770, filed on 20 March 2000.

On 30 September 2003, the Office issued an Election/Restriction Requirement.

On 31 October 2003, applicant cancelled claims 18-20 and added claims 21-23.

On 8 March 2004, the Examiner issued a non-final rejection of claims 1-17 and 21-23 as unpatentable over ***Business Wire*** (04/22/99), Swiss RE Develops Patent Validity Insurance for Patent and License Exchange, 2 pages, in view of an article by Margaret ***Quan***, Intellectual Property Exchange Takes Off, published on 10 March 2000 in EE Times, 1 page.

On 7 October 2004 (date on Return Receipt Post Card) applicant replied to the office action of 8 March 2004. The reply was entered on 13 September 2004.

On 21 September 2004, the application became abandoned in error for failure to respond to the Office Action. On 22 October 2004, the Office withdrew the holding of Abandonment.

On 3 January 2005, the Office issued a final rejection of claims 1-17, 21-23 as unpatentable over Business Wire and Quan.

On 6 May 2005, applicant requested continued examination. Applicant cancelled pending claims 1-17 and 21-23. Applicant added claims 24-43.

On 1 August 2005, the Examiner issued a non-final rejection.

On 6 January 2006, applicant filed a response.

Response to Amendment

Applicant's submission of 6 January 2006 has been entered.

Applicant amended claims 23-26 and 28-43. Claims 24, 35, 43 are independent.

Claims 24-43 are pending and will be examined.

Response to Arguments

Applicant's arguments filed 6 January 2006 have been fully considered but are not persuasive.

Objections to the claims are withdrawn in view of applicant's remarks.

On page 13, line 13-page 14, line 3, concerning claim 24, Applicant argues:

...Further, the Applicant is unable to find within Ginter et al. any discussion of such a multi-step, internet-based method that further includes a step in which the received information of the first is employed to make a determination regarding the availability or desirability of the intellectual property asset. In particular, the Applicant is unable to find such discussion within columns 269-272 of Ginter et al. [emphasis in original]

Further, the Applicant respectfully submits that it would not have been obvious to provide such a method in view of Ginter et al. As discussed at pages 25-26 of the Specification of the present Application, the Applicant's multi-step method is advantageous insofar as it allows a preliminary determination to be made regarding the intrinsic value of the particular intellectual property asset that is at issue, prior to addressing other more specific issues regarding the transfer of intellectual property, such as those relating to the exact extent of the interest in the intellectual property asset that is going to be transferred or other contractual details (e.g., price). In contrast, the Applicant is unable to find any discussion of such advantages or purposes (or the desirability of such advantages or purposes) in Ginter et al. For at least this reason, the Applicant respectfully submits that it would not have been obvious to one of ordinary skill in the art to arrive at the Applicant's claim 24 invention in view of Ginter et al.

In response to these arguments, the Examiner notes that the specification, page 25-26, on which applicant relies, does not mention "preliminary determination" although there is mention of ***intrinsic value***:

...Distinguishing between information concerning the nature of the P assets themselves and the specific (intellectual) property rights that the visitor is interested in having transferred is useful because it is typically the nature of the IP assets themselves (e.g., whether the asset is a 20 patent, or only a patent application, or whether the patent covers automobiles rather than merely engine valves) that determines the intrinsic value of the œ, both financially and in terms of whether IP1B 110 can identify specific third parties who are interested in the P. Once the intrinsic value of the IP is determined, this intrinsic value can be adjusted to account for the particular constraints limiting the ownership or possession of the P that 25 are desired by the P owner 120, P desirer 130 or IP1B 110. Specification, page 25, lines 17-25.

Thus applicant's claim language appears to be directed to determining the intrinsic value of the IP either (a) financially and (b) on whether the central site can identify specific parties that are interested in the IP asset.

The Examiner interprets applicant's comments concerning availability and desirability as referring to the following language in claim 24:

(c) receiving at the computer system, from the second party via the internet second information regarding an extent of the interest in the intellectual property asset **that is at least one of** potentially available for transfer from the second party to the first party and desired by the second party;

In the absence of an explicit definition of the above terms, the Examiner relies on the term's ordinary meaning and broadest reasonable interpretation. *E-Pass Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003). The Examiner submits that placing a bid and negotiating a contract are expressions of an extent of interest in an asset. Ginter, in the sections identified by applicant, discloses that the central site can identify specific second parties that are interested in the IP asset, since Ginter allows interested second parties to negotiate, bid and contract for rights to the IP asset (PP 233). The extent of interest is expressed vis-à-vis the asset, where the asset is (a) at least potentially available, since the second party can obtain rights, and is (b) desired by the second party, as expressed by negotiation and contract.

Art Unit: 3625

On page 15, line 15-page 16, line 26, as to claim 35, Applicant argues:

...Because the Applicant's claim 35 invention does not address the same problems as those addressed by Ginter et al., the Applicant respectfully submits that Ginter et al. lacks any suggestion to modify its teachings to arrive at the Applicant's claimed invention.

Ginter et al. appears to relate fundamentally to the secure transfer of "electronic content" that is susceptible to unauthorized copying [citation omitted]...

Because [Ginter] relates to [...secure transfer of "electronic content" that is susceptible to unauthorized copying...] [Ginter] apparently focuses upon systems that provide for the secure transfer of copyrighted material. In contrast, amended claim 35 specifically relates to the transfer of patent assets rather than copyrights.

In response to these arguments, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

On page 16, line 27-page 17, line 5, concerning claims 36-41, Applicant argues:

[claims 36-41] require the receipt of two types of information, and [is] applicable to transactions in which the first party is either a source or a recipient of an intellectual property asset.

... multiple types of patent-related information one or more of which are received as the "first information".

...the Applicant is unable to find any disclosure within Ginter et al. regarding receiving any of the various types of "first information" identified in claim 35.

...entirely lacks any suggestion to modify Ginter et al., or to combine Ginter et al. with plx, to arrive at these features.

Ginter et al. appears to relate fundamentally to the secure transfer of "electronic content" that is susceptible to unauthorized copying [citation omitted]...

Because [Ginter] relates to [...secure transfer of "electronic content" that is susceptible to unauthorized copying...] [Ginter] apparently focuses upon systems that provide for the secure transfer of copyrighted material. In contrast, amended claim 35 specifically relates to the transfer of patent assets rather than copyrights.

Unlike copyrightable subject matter such as software and other "electronic content," the copying of the particular expression within a patent asset does not affect the value of the patent asset, and consequently with respect to the transfer of patents there is no need for a system such as that proposed by Ginter et al. that prevents unauthorized copying.

Art Unit: 3625

Further, the Applicant additionally submits that, in any event, the Applicant is unable to find within plx any disclosure of the receipt of any of the types of patent-related information recited in amended claim 35.

In response to these arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

On page 16, lines 12-23, Applicant argues:

Because the Applicant's claim 35 invention does not address the same problems as those addressed by Ginter et al., the Applicant respectfully submits that Ginter et al. lacks any suggestion to modify its teachings to arrive at the Applicant's claimed invention. Also for this reason, Ginter et al. lacks any suggestion to combine its teachings with those of plx, which relates specifically to patents.

... Ginter [and] plx are not properly combinable to arrive at the Applicant's [claims] since plx concerns an intellectual property exchange, something which the Applicant's claimed invention is intended to improved upon and does not cover [sic]....

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

On page 16, lines 21-23, Applicant argues:

Further, the Applicant additionally submits that, in any event, the Applicant is unable to find within plx any disclosure of the receipt of any of the types of patent-related information recited in amended claim 35.

In response to this argument, the Examiner respectfully directs applicant's attention to page 1, question 2 of the FAQ sheet, which describes that one can

search for market information that is stored in a dataset. This particular question is copied here for applicant's convenience:

Q: HOW DO I FIND **PATENTS TO BUY OR LICENSE?**

A: The pl-x.com **database** is **market-oriented**. It allows you easy access to the qualitative and quantitative benefits a patent or other IP may offer. You can **search our database** by the **solution** you seek for your **market challenge**. Search results will include a variety of **market information** provided by the seller and will indicate the complete terms of the offering. [emphasis added, for applicant's convenience]

Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Objections

Claim 34 refers to "a trademark" twice, apparently a word processing error.

Claim Rejections - 35 USC § 112

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 refers to "...processing operation involves a determination of whether the intellectual property asset is at least one of potentially desired by the first party and

Art Unit: 3625

potentially available for transfer from the first party..." Applicant's specifications refer to intrinsic value, and it is not clear how one determines what is intrinsic or "...potentially desired..."

Claim 24 refers to information regarding a nature of an IP asset as first information. Claim 31 refers to information regarding the nature of an IP asset as first information and third information. Claim 31 uses "third information" as referring to identification information identifying the second party; claim 32 users "third information" to refer to information regarding a bid price for the interest in the IP asset.

It is not clear what's intended to be covered by the different types of information.

Claims 42-43 refer to a first through fifth party. It is impossible to identify who the first party and second party correspond to in the disclosures. For purposes of this Examination, the first and second parties will be considered to be the same first and second party of claims 35-41.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

As best understood by the Examiner, the roles played by each actor and label according to applicant's latest shuffling is presented below. Several equivalents in Ginter are also noted, for applicant's convenience.

Actor and label	Claims 24-34	claims 35-41	Claims 42, 43
Asset	IP asset	Patent asset	
Interest	Claim 30 list of rights sought	Claim 41 list, rights sought	
First party	Claims 24-26, 33: Rights	Claim 35, Content creator 102	Unknown

Art Unit: 3625

Actor and label	Claims 24-34	claims 35-41	Claims 42, 43
	distributor 106		
Second party	Claims 24, 31: Content user 112	Content user 112	Unknown
Third party	Claim 33, Content creator 102	Rights distributor 106	Rights distributor 106
Fourth party			IP exchange
Fifth party			Claim 43, Service entity; claim 42, lawyers, accountants,
First information	Claim 29 list, Title, Patent #, filing date, details concerning item sought	Nature of patent asset, identify, type, technology focus, product relationship, market scope	
Second information	Claims 30 list, Rights sought	Claim 41 list, rights sought	
Third information	Claim 31, second party identification information; Claim 32, bid price Claim 33, regarding the nature of the IP asset	None	none
First interest		Claim 41 list, rights sought	
Second interest		Claim 41 list, rights sought	
Third interest			Claim 43
First contract		Between first party and second party	Between third party (rights distributor) and second party
Second contract		Between first party and third party	

Claims 24-27, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (5,892,900).

As per claim 24, Ginter discloses an internet-based (Col. 18, line 39-Col. 19, line 8, Col. 24, line 54-Col. 25, line 27) method of executing a transaction involving a transfer of an interest in an intellectual property asset (Col. 43, line 21-42) between a first party (Rights Distributor 106) to and a second party (Content User 112), the method comprising:

(a) **receiving** at a computer system of the first party (Rights Distributor 106), from the second party (Content User 112) via the internet, first information (title, details) regarding a nature of the intellectual property asset. See, for example, at least Col. 284, lines 5-53.

- (b) **performing**, at least partly by way of the computer system of the first party (Rights Distributor 106), at least one processing operation in response to the receiving of the first information, wherein the processing operation involves a determination of whether the intellectual property asset is at least one of potentially desired by the first party (Rights Distributor 106) and potentially available for transfer from the first party (Rights Distributor 106).
- (c) **receiving** at the computer system, from the second party (Content User 112) via the internet. second information regarding at least one an extent of the interest in the intellectual property asset that is at least one of potentially available for transfer from the second party (Content User 112) to the first party (Rights Distributor 106) and desired by the second party (Content User 112). See, for example, at least Col. 269-272, concerning negotiating and contracting for an IP asset. See also response to arguments concerning this limitation.
- (d) **providing** a proposed agreement onto the internet regarding the transfer of the interest in the intellectual property asset between the first party (Rights Distributor 106) to and the second party (Content User 112), wherein the agreement is generated at least in part based upon the second information and
- (e) **receiving** an indication of acceptance of the proposed agreement by the second party (Content User 112), whereby the transaction- involving the transfer of the interest in the intellectual property asset between the first party first party (Rights Distributor 106) and second party second party (Content User 112) is executed.

As per claim 25, Ginter discloses that processing includes **at least one of**

- (i) checking a status of the intellectual property asset. Please see references to status, at least Col. 169, lines 27-40.
- (ii) determining whether the intellectual property asset is owned by the first party (Rights Distributor 106):
- (iii) analyzing a technology relating to the intellectual property asset:
- (iv) analyzing a product relating to the intellectual property asset: see, for example, references to auditing and analyzing use of content, as in Col. 8, lines 20-36, Col. 308, lines 36-61.
- (v) analyzing a market relating to the intellectual property asset. Ginter, Col. 36, lines 10-43, for example;
- (vi) reviewing recorded information concerning at least one additional transaction with which the first party (Rights Distributor 106) has been involved,
- (vii) reviewing recorded information concerning at least one inquiry that the first party (Rights Distributor 106) has received;
- (viii) conducting an acquisition of at least one desired intellectual property asset, and
- (ix) generating evaluation information relating to the intellectual property asset.

As per claim 26, Ginter discloses that the first party (Rights Distributor 106) is an intellectual property investment bank that owns the interest in the intellectual property asset prior to the transaction being executed and wherein the processing operation includes at least **two** of (i) - (ix). For analyzing a **market** relating to the intellectual property asset. Ginter, Col. 36, lines 10-43, for example. For status, see Ginter at least references to **status**, as in Col. 169, lines 27-40.

As per claim 27, Ginter discloses that the proposed agreement is at least partly generated in an automatic manner, and wherein the processing operation includes at least **three** of (i) – (ix). For analyzing a **market** relating to the intellectual property asset. Ginter, Col. 36, lines 10-43, for example. For status, see Ginter at least references to **status**, as in Col. 169, lines 27-40. For analyzing a product relating to the intellectual property asset, see, for example, references to auditing and analyzing use of content, as in Col. 8, lines 20-36, Col. 308, lines 36-61.

As per claim 32, Ginter discloses receiving at the computer system, via the internet, third information regarding a bid price for the interest in the intellectual property asset. See, for example, at least Col. 269-272 and references to bidding, negotiations and contracts.

As per claim 33, Ginter discloses that (a)-(e) concern the transfer of the interest in the intellectual property asset from the first party (Rights Distributor 106) to the second party (Content User 112), as above in reference to claim 24, and further comprising, prior to (a):

receiving at the computer system, from the internet, at least one of the first information and third information regarding the nature of the intellectual property asset. See, for example, at least Col. 284, lines 5-53 concerning first information such as author's name, creation date, etc.

providing an additional proposed agreement onto the internet regarding an additional transfer of at least one of the interest in the intellectual property asset and an

additional interest in the intellectual property asset. See, for example, at least Col. 19, lines 8-28, concerning proposed agreements.

receiving an indication of acceptance of the proposed agreement by a third party (Content Creator 102), Ginter Col. 19, line 28-Col. 20, line 3.

whereby an additional transaction involving the intellectual property asset is executed between the first party (Rights Distributor 106) and third party (Content Creator 102), so that the first party (Rights Distributor 106) obtains the interest in the intellectual property asset that is subsequently transferred to the second party (Content User 112). See, for example, at least Col. 180, lines 3-25, Col. 227, line 66-Col. 228, line 10.

As per claim 34, Ginter discloses that processing includes storing of information in a database, as in Col. Col. 9, lines 19-34. Ginter discloses that the intellectual property asset is at least one of patent, a pending patent application, an invention, a trademark, a trade secret and a copyright. See, for example, references to copyright rights of a creator for the content, as in Col. 47, lines 21-55.

Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (5,892,900) in view of plx.

As per claim 28, Ginter discusses intellectual property (Col. 43, lines 22-43) but **does not** specifically disclose that the property asset is a patent.¹ This is disclosed by **plx**. It would have been obvious to one of ordinary skill in the art to combine Ginter and **plx** to disclose intellectual property such patents. One of ordinary skill in the art at the

time the invention was made would have been motivated to combine Ginter and *plx* to disclose intellectual property such as patents because patents are another valuable asset that can be searched, licensed and sold according to negotiation and executed via electronic contracts. It would have been obvious to include transfer of interests in other types of intellectual property, including patents.

As per claim 29, Ginter discloses that the first information regarding the Intellectual Property includes at least one of a Intellectual Property number, a filing date of the Intellectual Property, a title of the Intellectual Property, an issue date of the Intellectual Property, Intellectual Property expiration information, an inventor listed on the Intellectual Property, Intellectual Property ownership information, a technical subject matter of the Intellectual Property, product information regarding a product within a scope of the Intellectual Property and a market (Ginter, Col. 36, lines 10-43, for example) with respect to which the Intellectual Property is applicable.

As per Claim 29, Ginter **does not** specifically apply the above to a patent. Official Notice is taken that Intellectual Property assets includes patent assets. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ginter and knowledge of one of ordinary skill in the art to extend Ginter's Intellectual Property assets to patent assets and disclose first information applicable to patents, including at least one of a patent number, a filing date of the patent, a title of the patent, an issue date of the patent, patent expiration information, an inventor listed

¹ Applicant's definition of intellectual property asset includes patents, copyrights and trademarks. Page 8, lines 15-18.

on the patent, patent ownership information, a technical subject matter of the patent, product information regarding a product within a scope of the patent and a market.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Ginter and knowledge of one of ordinary skill in the art to extend Ginter's Intellectual Property assets to patent assets and disclose first information applicable to patents, including at least one of a patent number, a filing date of the patent, a title of the patent, an issue date of the patent, patent expiration information, an inventor listed on the patent, patent ownership information, a technical subject matter of the patent, product information regarding a product within a scope of the patent and a market for the obvious reason that patents are also valuable IP assets.

As per claim 30, Ginter discloses second information includes licensing and royalties. Ginter, Col. 33, lines 35-65.

As per claim 30, Ginter **does not** specifically apply the above to a patent. Official Notice is taken that Intellectual Property assets includes patent assets. It would have been well within the skill of one of ordinary skill in the art at the time the invention was made to include patents within Ginter's Intellectual property and disclose at least one of licensing and royalties (at least in Col. 33, lines 35-65) to patent assets.

One of ordinary skill in the art at the time the invention was made would have been motivated to include patents within Ginter's Intellectual property and disclose at least one of licensing and royalties (at least in Col. 33, lines 35-65) to patent assets for the obvious reason that patents are also valuable IP assets that can be licensed and exchanged for royalties.

As per claim 31, Ginter discloses receiving at the computer system via the internet (Col. 18, line 39-Col. 19, line 8, Col. 24, line 54-Col. 25, line 27) third information regarding identification information identifying the second party (Content User 112), Col. 324, lines 12-44.

Claims 35-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (5,892,900) in view of plx.

As per claims 35-41, Ginter discloses method(s) of facilitating a transfer of a first interest in an intellectual property asset between first party and second party the method comprising:

receiving, at a computer system of the first party off of an internet-type communications link, first information concerning the patent asset, wherein the first information includes at least one of [as in **claim 29**]:

a number identifying the patent asset, a filing date, an issue date, expiration information, a title, an inventor name, ownership information, descriptive information concerning a technical subject matter of the patent asset, product information regarding a product that is within a scope of the patent asset and market information (Ginter, Col. 36, lines 10-43, for example) regarding a market to which the patent asset pertains. See also **plx**, page 1, question 2.

receiving second information regarding an extent of the first interest in the patent asset. See claim 24.

providing a proposed agreement onto the internet regarding the transfer of the first interest in the patent asset between the first party and second party. See claim 24.

transferring the first interest in the patent asset from one of the first party to the other of the first party and the second party by concluding a first agreement between the first party and the second party. See claim 24.

Ginter discloses the features of claims 35-41 for intellectual property. Intellectual Property includes patents.

As per claims 35-41, Ginter **does not** specifically apply the invention to an intellectual property asset called a patent. **Plx** discloses features of an exchange for the type of intellectual property called patents. Official Notice is taken that intellectual property includes patents.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ginter and plx to disclose applicability to patents.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Ginter and plx to disclose applicability to patents for the obvious reason that patents are an important feature of patent and may be similarly licensed for revenue, permitting a person to derive income for his creativity.

As per claim 43, Ginter discloses facilitating transfer one or more interests in an intellectual property asset among first and second parties by way of a third party that is an central distributor (rights distributor 106), operating in association with multiple parties that may serve to exchange interests in intellectual property, a other parties that may be service entities (including law firms with lawyers and accountants).

An exchange is a place where things are or services are exchanged.² Ginter discloses that content may be sold and resold along value chains and chains of handling. See, for example, references to six agreements in an extended agreement for a particular value chain instance, as in Col. 47, lines 21-55, Col. 333, line 37-Col. 334,

² Definition of *exchange*, MERRIAM WEBSTERS Collegiate Dictionary

line 17. See also at least Col. 5, lines 14-45, which discloses that participants of the distribution can freely exchange content and associated control sets, corresponding to applicant's "...intellectual property exchange..."

Ginter discloses method(s) of facilitating exchanging first interest in an intellectual property between first party (VDE Content Creators 102) and second parties (VDE Content User 112) by way of a third party that is an *IPIB* (VDE Rights Distributor 106) and any one of additional parties, including applicant's "...Intellectual Property Exchange..." See rejection of claims 24 and 25. For roles of one or more intermediaries, please see at least Figs. 80-87. For ClearingHouse, please refer to Fig. 87, reference 116. Transfer of interests among the parties is accomplished via negotiated contracts, as in Col. 259, line 15-Col. 260, line 36.

Ginter **does not** provide specific examples of Set (a) or set (b), listed in Claim 43. It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Ginter to disclose (i) transferring a second interest in the intellectual property asset from the first party to the *IPIB* so that the *IPIB* obtains the second interest in the intellectual property asset, wherein the second interest at least one of encompasses and is identical to the first interest; (ii) providing first information regarding the intellectual property asset from the *IPIB* to the intellectual property exchange; (iii) receiving a first bid from the second party concerning the first interest in the intellectual property asset via the intellectual property exchange; and (iv) executing a first agreement between the *IPIB* and the second party so as to transfer the first interest in the intellectual property asset from the *IPIB* to the second party.

One of ordinary skill in the art at the time the invention was made would have been motivated to extend Ginter to disclose (i) transferring a second interest in the intellectual property asset from the first party to the IPIB so that the IPIB obtains the second interest in the intellectual property asset, wherein the second interest at least one of encompasses and is identical to the first interest; (ii) providing first information regarding the intellectual property asset from the IPIB to the intellectual property exchange; (iii) receiving a first bid from the second party concerning the first interest in the intellectual property asset via the intellectual property exchange; and (iv) executing a first agreement between the IPIB and the second party so as to transfer the first interest in the intellectual property asset from the IPIB to the second party for the obvious reason that this allows multiple parties to partake in a chain of value to use the intellectual property.

Ginter **does not** use the labels "...intellectual property investment bank..." and "...intellectual property exchange..."

However, the labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. The labels themselves carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a label to various actors and modules in a system such as *Ginter* because such data does not functionally relate to the substrate

of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

As per claim 42, Ginter discloses that a service entity encompasses at least one of a lawyer and an accountant. See, for example, references to law firms and attorneys, as in Col. 300, line 5-43.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

Art Unit: 3625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jk
James Zurita
Patent Examiner
Art Unit 3625
4 April 2006

Mark Fadd
Mark Fadd
Action - SPE 3625